

REMARKS**Status of the Claims**

Claims 1-11 were previously canceled and new claims 12-20 were presented for examination. The Examiner refused to enter the new claims on the ground that they are not readable on the examined invention. Claims 12-20 are resubmitted herein without any amendments. Entry of the claims and their consideration on the merits are respectfully requested.

Notice of Non-Responsive Amendment

The Examiner asserted that the amendment filed on June 13, 2008, which canceled claims 6-11 and introduced claims 12-20, was non-responsive under MPEP § 821.03 because the new claims are allegedly independent and distinct from the invention already examined (i.e., claims 6-11). The Examiner alleged that claims 12-20 are “not readable on the examined invention because the claims already examined were drawn to on an isolated gene and use of said gene to treat plant diseases, while the new claims are drawn to a method of identifying a *Xanthomonas campestris* (*Xcc*) gene directly involved in pathogenicity using a broad host range cosmid comprising a transposon and a plurality of *Xcc* cells.”

Applicants respectfully disagree. The section cited by the Examiner is a part of the MPEP chapter dealing with restriction practice. Accordingly, this section is only applicable to claims that have been subject to a restriction requirement, which is clearly not the case here. Since claims 6-11 were never restricted, the patent rules do not preclude Applicants from cancelling all pending claims and submitting new claims, as long as the new claims are adequately supported by the specification.

Moreover, Applicants respectfully submit that it would be wasteful, inefficient and contrary to public policy to require an applicant to abandon a pending application and file a new divisional application after a single Office action on the merits, particularly where no significant additional searching would be required for the examination of newly submitted claims. Both claims 6-11 and claims 12-20 directly or indirectly pertain to genes involved in *Xanthomonas campestris* (*Xcc*)

pathogenicity and/or metabolism. Judging by the first Office action, the Examiner has already carried out an extensive prior art search in this area. Accordingly, there would not be a serious burden on the Examiner to examine the new claims, which is one of the two basic criteria for a proper restriction requirement under MPEP § 803.1.

In light of the foregoing, Applicants respectfully submit that the Notice of Non-Responsive Amendment was improper under the specific circumstances of this patent application, and request that the amendment filed on June 13, 2008 be entered and examined on the merits. If the Examiner determines that a telephone conference would expedite the prosecution of this application, the Examiner is invited to call Applicants' representative at the phone number provided below.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **docket No. 606932000100**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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